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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES**

In re Application of: SEUNG-CHEOL HONG *et al.*

Appeal No. _____

Original Patent No. 5,944,830 issued on 31 August 1999

Serial No.: 09/942,961

Examiner: MYERS, PAUL R.

Filed: 31 August 2001

Art Unit: 2189

For: REDUCING POWER CONSUMPTION IN MONITOR BY SWITCHING OFF
HEATER POWER IN POWER-OFF MODE

Attn: Board of Patent Appeals and Interferences

REPLY BRIEF

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Sir:

Pursuant to 37 C.F.R. §1.193(a) and (b), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer mailed on 2 December 2003 (Paper No. 21).

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)), together with a written Request for An Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

Folio: P54428RE
Date: 2/2/4
I.D.: REB/kf/rfc

REMARKS

In response to the December 2, 2003 Examiner's Answer, the following is submitted:

In section 11 on pages 5-6 of the Examiner's Answer, the Examiner has clearly confused the term "earlier art" with the term "prior art". The Examiner's arguments make it apparent that he considers the two terms to be synonymous. However, the two terms are not synonymous for the following reasons:

It is agreed that the term "earlier art" refers to art that existed prior to the invention by the applicant. In accordance with 35 USC §§ 102 and 103, however, art that existed prior to the invention by the applicant is not necessarily prior art.

For example, 35 USC § 102 (e) states in part that a person shall be entitled to a patent unless "the invention was described in -- (1) an application for patent, published under § 122 (b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in § 351(a) shall have the effects for the purpose of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language."

35 USC § 103 (c) then states that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of § 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person are subject to an obligation of assignment to the same person."

In view of the above, if the apparatus illustrated in Figure 1 of the present application was described in a published application for patent filed earlier than the invention by the applicant but the subject matter and claimed invention of the earlier application was owned by the same assignee, then the published application, while being earlier than the invention by the applicant, is nevertheless not prior art within the meaning of 35 USC §§ 102 and 103.

Stated in other terms, all "prior art" within the meaning of 35 USC §§ 102 and 103 existed earlier than the filing date of a subject application but all "earlier art" is not necessarily prior art within the meaning of 35 USC §§ 102 and 103.

While no case directly on point was located during legal research, Riverwood International Corp.v.R.A period Jones & Co., 66 USPQ2d 1331 (CAFC 2003), in referring to whether the inventors' own work could be considered to be prior art by admission, stated the following:

While Nomiya and Fout stand for the proposition that a reference can become prior art by

admission, that doctrine is inapplicable when the subject matter at issue is the inventor's own work. In *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the examiner considered material from the preamble of a Jepson claim as prior art when making an obviousness rejection. *Id.* at 909-10, 200 USPQ at 510. The *Ehrreich* court found that rather than making an admission about the scope and content of the prior art, the applicant used Jepson language to avoid a double patenting rejection in the applicant's co-pending application. *Id.*, 200 USPQ at 510. That co-pending application was not available to the public, was not the work of another, and was therefore not prior art under any statutory provision. The court concluded: "We think that a finding of obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103." *Id.*, 200 USPQ at 510.

In *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984), this court again considered an obviousness challenge to a patent in which certain claims referred to the patentee's own patent in both the specification section entitled "Summary of the Prior Art" and in the preamble to a Jepson claim. The *Reading & Bates* court held that the reference in the Jepson claim preamble to the applicant's own prior work was not prior art, citing the reasoning and policy of *Ehrreich* that "the preamble, standing alone, was not an admission that one's own prior work is prior art." *Id.* at 649, 223 USPQ at 1171. It also held that the patentee's discussion of his own patent in the specification section entitled "Summary of the Prior Art" did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the "policy behind requiring a statutory basis before one's own work

may be considered as prior art.” *Id.* at 650, 223 USPQ at 1171 (citing *In re Fout*, 675 F.2d 297, 213 USPQ 532).

Accordingly, the “earlier art” could be by the inventor, for example, and **not be** “prior art” within the meaning of 35 USC §§ 102 and 103.

In view of the above, it is submitted that the Examiner's presumption that the “earlier art” discussed in the present specification was “Applicants' Admitted Prior Art” within the meaning of 35 USC §§ 102 and 103 was **incorrect** and accordingly, the Examiner's prior art rejection of the claims based on the “Applicants' Admitted Prior Art” in combination with Heineman is clearly improper and should be reversed.

A Request for Oral Hearing and an Appellants' check in the amount of \$290.00 (Check No.45234) drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fee.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202)408-9040

Folio: P54428RE
Date: 02/02/4
I.D.: REB/kf